

APR. 27. 2009 3:15PM

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NO. 6141 P. 2

APR 27 2009

Docket No. 21408 US (C038435/0185946)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*In re* Patent Application of: )

Michihiko KATAOKA and Sakayu SHIMIZU )

Serial No.: 10/528,960 )

Filed: October 31, 2005 )

For: **ENONE REDUCTASE GENE  
AND MICROBIAL PRODUCTION  
OF LEVODIONE** )

Examiner: M. Y. Meah

Art Unit: 1652

New York, New York  
April 27, 2009**SUPPLEMENTAL RESPONSE INCLUDING INTERVIEW SUMMARY,  
AND SUBMISSION OF TERMINAL DISCLAIMER**Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Subsequent to the filing of the Response to Office Action Including Amendment dated February 13, 2009, Examiner Mohammed Meah contacted the undersigned on April 10, 2009, to indicate that amendments to claim 7 are required and that a Terminal Disclaimer with regard to U.S. Patent No. 7,202,068 is required. The undersigned indicated that the required amendments to claim 7 would be considered. The Examiner indicated that the obviousness-type double patenting rejection over this patent would be withdrawn upon filing the requested Terminal Disclaimer. The Examiner also indicated that he believed that the application would be allowable upon making the required amendments and filing the Terminal Disclaimer.

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NO. 6141 P. 3

Application No.: 10/528,980  
Supplemental Response Dated: April 27, 2009

On April 24, 2009, the Examiner and the undersigned again spoke by telephone. Agreement was reached that the Examiner's required amendments will be made. Also, the Examiner agreed to the deletion of the pH and temperature range limitations at the end of claim 7, and the addition of a new claim which would depend from claim 7, reciting these pH and temperature range limitations. The Examiner agreed to make the amendments by Examiner's Amendment upon receipt of the Terminal Disclaimer. We thank the Examiner in advance, for preparing the Examiner's Amendment.

Although we do not agree with the Examiner's determination of obviousness-type double patenting, to comply with the Examiner's requirement and thus further prosecution in the present application, submitted herewith is the requested Terminal Disclaimer.

Please charge our Deposit Account No. 02-4467 in the amount of \$140.00 for the filing of the Terminal Disclaimer. 37 CFR § 1.20(d).

It is believed that no further fees are due. If the fee authorized is insufficient or if any additional fees are due, please charge our Deposit Account No. 02-4467 for such fee(s). A duplicate copy of this paper is provided.

It is respectfully submitted that the application is now in condition for allowance. Issuance of a Notice of Allowance is requested.

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NO. 6141 P. 4

Application No.: 10/528,960  
Supplemental Response Dated: April 27, 2009

On April 24, 2009, the Examiner and the undersigned again spoke by telephone. Agreement was reached that the Examiner's required amendments will be made. Also, the Examiner agreed to the deletion of the pH and temperature range limitations at the end of claim 7, and the addition of a new claim which would depend from claim 7, reciting these pH and temperature range limitations. The Examiner agreed to make the amendments by Examiner's Amendment upon receipt of the Terminal Disclaimer. We thank the Examiner in advance, for preparing the Examiner's Amendment.

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NO. 6141 P. 5

Application No.: 10/528,960  
Supplemental Response Dated: April 27, 2009

Please contact the undersigned if there are any questions related to this paper.

I hereby certify that this correspondence is being transmitted to the United States Patent Office via facsimile transmission at (571) 273-8300 on April 27, 2009.

  
Eileen M. Ebel, Reg. No. 37,316

Respectfully submitted,

By: 

Eileen M. Ebel  
Registration No. 37,316  
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1290 Avenue of the Americas  
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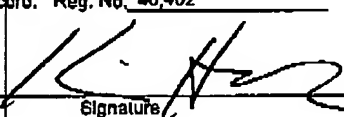
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NO. 6141 P. 6

PTO/SB/26 (03-09)

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TERMINAL DISCLAIMER TO OBTAIN A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT</b>		Docket Number (Optional) C038435/0185946
<p>In re Application of: Michihiko KATAOKA and Sakayu SHIMIZU</p> <p>Application No.: 10/528,960</p> <p>Filed: October 31, 2005</p> <p>For: ENONE REDUCTASE GENE AND MICROBIAL PRODUCTION OF LEVODIONE</p>		
<p>The owner, <u>DSM IP Assets B.V.</u> of <u>100</u> percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. <u>7,202,068</u> as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:</p> <ul style="list-style-type: none"> <li>expires for failure to pay a maintenance fee;</li> <li>is held unenforceable;</li> <li>is found invalid by a court of competent jurisdiction;</li> <li>is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;</li> <li>has all claims canceled by a reexamination certificate;</li> <li>is reissued; or</li> <li>is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</li> </ul> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input checked="" type="checkbox"/> The undersigned is an attorney or agent of record. Reg. No. <u>40,402</u></p> <p style="text-align: center;">         Signature     </p> <p style="text-align: right;"> <u>April 27, 2009</u>        Date     </p> <p style="text-align: center;"> <u>Kevin C. Hooper</u>        Typed or printed name     </p> <p style="text-align: right;"> <u>212-541-2000</u>        Telephone Number     </p> <p><input checked="" type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <p>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</p>		

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-0199 and select option 2.